

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-7 and 10-12 are now present in this application. Claims 1-3, 6 and 10-12 are independent. By this Amendment, claims 1-3, 6 and 10-12 have been amended, and claims 13-20 have been canceled. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

I. Rejection Under 35 U.S.C. §112, 2nd Paragraph

Claims 1-7 and 10-12 stand rejected under 35 U.S.C. §112, second paragraph, because the language “the second conveying rollers” lacks proper antecedent basis. This rejection is respectfully traversed.

In order to overcome this rejection, claim 1 has been amended to remove the word “second” so that the terminology in issue now reads --the conveying rollers--, which Applicant respectfully submits finds proper antecedent basis in claim 1.

Accordingly, Applicant respectfully submits that claims 1-7 and 10-12 are in full compliance with 35 U.S.C. §112, second paragraph, and thus, the rejection should be withdrawn.

II. Rejection Under 35 U.S.C. §102

Claims 1 and 3-4 have been rejected under 35 U.S.C. §102(b) as being anticipated by Ariga (GB 2132737). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). This burden can be satisfied when the PTO presents evidence, by means of some teaching, suggestion or inference either in the applied prior art or generally available knowledge, that would have appeared to have suggested the claimed subject matter to a person of ordinary skill in the art or would have motivated a person of ordinary skill in the art to combine the applied references in the proposed manner to arrive at the claimed invention. See Carella v. Starlight Archery Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985),

cert. denied, 475 U.S. 1017 (1986); In re Rinehart, 531 F.2d 1048, 1051-1052, 189 USPQ 143, 147 (CCPA 1976).

If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Initially, Applicant respectfully disagrees with the Office Action's interpretation of what parts of Ariga correspond to the claimed invention.

The Office Action asserts that Ariga's feed rollers 6a and 6b are "first separating rollers . . . to separate the media one by one" – page 4, lines 1-3.

Applicant respectfully disagrees and submits that Ariga's feed rollers 6a and 6b are actually conveying rollers that convey the paper P to the Ariga's takeout rollers 7a, 7b and 7c, which correspond to first separating rollers, that separate single sheets of paper P from what is being fed by feed rollers 6a and 6b. Applicant does agree that Ariga's gate rollers 17a and 17b can be considered to be second separating rollers. These comments are also presented in rebuttal to the arguments presented on page 5 of the outstanding Office Action's "Response to Amendment" section, which incorrectly treat Ariga's feed rollers 6a, 6b as separation rollers. Moreover, it is in this context that the following remarks are made,

Claim 1, as amended, recites a combination of features including first separating rollers arranged with overlaps to the conveying rollers to separate the media passing therebetween one by one, and second separating rollers arranged to face an outer surface of at least some of the conveying rollers with gaps between the facing second separating rollers and the conveying rollers, for generating a frictional force to the media passing between the conveying rollers and the facing second separating rollers. Ariga does not disclose such a combination of features. In fact, Fig. 7 of Ariga clearly shows that the gate rollers do not face the feed rollers nor do that generate a force therebetween to the media. In contradistinction to what is claimed, Ariga's gate rollers act in

conjunction with Ariga's to exert a force on the media P – see page 2, lines 74-92, for example. Ariga's gate rollers do not act with the feed rollers.

Accordingly, Ariga does not disclose the claimed invention.

Accordingly, independent claim 1 and its dependent claims (due to their dependency) are patentable over the applied reference, and thus the rejection is improper and must be withdrawn.

Further, with respect to claim 3, Applicant respectfully submits that the Office Action incorrectly indicates that takeout rollers 7a, 7b and 7c are the conveying (or feed) rollers. However, Ariga's conveying or feed rollers are actually feed rollers 6a, 6b and Ariga's feed rollers 6a, 6b are not disclosed as first conveying rollers with overlaps to first separating rollers and second conveying rollers with arranged face-to-face with second separating rollers.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of claim 3 by Ariga. Similar comments apply to claim 4, which depends from claim 3.

III. Allowable Subject Matter

Because claims 2 and 5-7 have not been rejected over any prior art of record, these claims should be indicated as allowable over the prior art of record in view of the fact that the rejection of these claims under 35 U.S.C. §112, second paragraph has been overcome for reasons stated above. Moreover,

because claims 2 and 6 have been re-written in independent form and the rejection of claims 1-7 and 10-12 under 35 USC §112, second paragraph has been overcome, for reasons stated above, Applicant respectfully submits that claims 2, 6 and 7 (which depends from claim 6) are in condition for allowance.

IV. Additional Cited Reference

Because the remaining reference cited by the Examiner in the outstanding Office Action has not been utilized to reject the claims, but has merely been cited to show the state of the art, no comment need be made with respect thereto.

V. Conclusion

It is believed that a full and complete response has been made to the outstanding Office Action. All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that (1) the Examiner reconsider all presently outstanding rejections and that they be withdrawn, (2) the proposed amendments be entered; and (3) this Application be promptly passed to issue.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

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Art Unit 3653

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Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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